



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/976,566	11/24/1997	ANDREW A. POTTER	9001-0016.01	2057

20855 7590 07/30/2002

ROBINS & PASTERNAK LLP  
545 MIDDLEFIELD ROAD  
SUITE 180  
MENLO PARK, CA 94025

EXAMINER
----------

GRASER, JENNIFER E

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 07/30/2002

20

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.

08/976,566

Applicant(s)

Potter et al

Examiner

Jennifer Graser

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 6, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires four months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: none
- Claim(s) objected to: none
- Claim(s) rejected: 37, 40, 41, 44 and 45
- Claim(s) withdrawn from consideration: \_\_\_\_\_
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Art Unit: 1645

1. The examiner acknowledges the after final amendment to the claims filed 6/6/02. The amendment will be entered.
2. The rejection of claims 37, 40, 41, 44 and 45 under 35 USC 103 as being unpatentable over Potter in view of Bell is maintained essentially for reasons set forth in the previous office action. Applicant urges that Potter does not disclose that leukotoxin could itself perform as a carrier, that Bell is silent on the immunogenicity of chimeras and is not concerned with creating a vaccine. It is the examiner's position that it appears that applicant argues the identification of a new property for an already existing composition. The mere discovery that a claimed composition possesses a property not disclosed in the prior art does not alone defeat a prima facie case of obviousness and it is not necessary, in order to establish a prima facie case, to show both structural similarity between the claimed composition and that of the prior art and suggestion in, or expectation from, the prior art composition that the claimed composition will have the same or similar property as one newly discovered by applicant. See In re Dillon 16 USPQ2d 1897 (Fed. Cir., 1990).
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jennifer Graser whose telephone number is 703-308-1742.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703) 308-3909.

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600